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10/709,497	05/10/2004	Joe Stockwell	37015.0300	3496

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SNELL & WILMER L.L.P. (Main)  
400 EAST VAN BUREN  
ONE ARIZONA CENTER  
PHOENIX, AZ 85004-2202

EXAMINER
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WRIGHT, PATRICIA KATHRYN

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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02/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/709,497	<b>Applicant(s)</b> STOCKWELL, JOE	
	<b>Examiner</b> P. Kathryn Wright	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to papers filed December 01, 2008 in which claims 1-11 were amended. The amendments have been thoroughly reviewed and entered.

New grounds for rejection, necessitated by the amendments, are discussed.

Claims 1-11 are under prosecution.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7-8 recites the plugs in the penultimate line. There is a lack of antecedent basis for the "the plugs". The Examiner believes all recitation to the "plugs" should be amended to -- the plug members-- for consistency.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Carl (US Patent No. 5,497,670).

Carl teaches an apparatus for transferring pipette tips comprising a transfer plate 16 having a plurality of plug members (cylinders 26). The plug members engage the pipette tips 20 disposed in a frame 18. Carl teaches the frame 18 being assembled and interlocked with the transfer plate via shafts 12, 14. The frame 18 has openings (see Fig. 5) for inserting the plug members 26 therethrough to engage the pipette tips 20. The frame 18, as shown in greater detail in Fig. 5, includes a plurality of protuberances 22, 28 which are smaller than the plug members 26 and extend into the openings (see Fig. 7).

As to claim 2, the plug members 26 are arranged in parallel lines separated by elongated slots (openings in the plate 16), see Figs. 4 and 7.

Regarding claim 3, the openings in the frame 18 of Carl comprise “elongated” slots separated by “elongated” rails. Note that the limitation “elongated slots” reads on the openings in the frame in which the pipette tips are disposed, shown Fig. 5. Likewise, the limitation “elongated rails” reads on the area between the openings in which the tips are disposed, shown in Fig. 5 with hatched lines. The dimensions of the openings or slots are not defined in the claim or the specification, thus, the openings of Carl in the frame and the area in-between the openings can be considered “elongated slots” to one of ordinary skill.

As to claim 5, the plug members 26 are hollow to accept the piston 32 therein, see Fig. 6.

Claim 6 functionally describes the operation of the apparatus. Please note that a recitation with respect to the manner in which a claimed apparatus is intended to be

operated fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. Nevertheless, Carl does, in fact, teach vertically sliding the transfer plate 16 (e.g., down) relative to the frame 18, see Figs. 4 and 7. The transfer plate 16 can be slid downward to a “retained and a released position” wherein the plugs 26 have pipette tips positioned thereon (see Fig. 4).

Regarding claim 7, the protuberances 20, 28 are in contact with the pipette tips, positioned over the plug members, when the apparatus is in the retained position as shown in Fig. 4.

As to claim 8, the protuberances 22, 28 are located between the plug members 26 when the apparatus is in a released position (i.e., when the transfer plate 16 is moved vertically downward so that the plugs engage the pipette tips).

As to claim 9, the transfer plate 16 further comprises at least one “tab member” for sliding the frame relative to the transfer plate. That is, the shaft 12 of Carl reads on the “tab member” since it allows the frame 18 to slide relative to the transfer plate 16. Nothing in the claim structurally distinguishes the tab member from the shaft of Carl.

With regard to claim 10, transfer plate 16 and the frame 18 are generally rectangular in shape, see Fig. 3.

As to claim 11, the transfer plate 16 and the frame 18 are removable from one another (i.e., separated when the transfer plate is slid upward along shafts).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carl (US Patent No. 5,497,670).

The teachings of Carl have been summarized above. Carl does not explicitly teach the transfer plate and the frame being comprised of a moldable plastic.

However, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to construct the transfer plate and frame from a moldable plastic since the skilled artisan would be able determine the optimum materials of construction based on considerations such as cost, ease of manufacture, reactions with the processing agents and/or maintaining the required reaction conditions with respect to temperature.

***Response to Arguments***

9. Applicant's arguments filed December 01, 2008 have been fully considered but they are not persuasive. In response to the previous rejection of claims 1-3 and 5-11 under 35 U.S.C. 102(b) as being anticipated by Carl (US Patent No. 5,497,670).

Applicant argues that independent claim 1 requires that the transfer plate 16 have (i.e. include) a plurality of plug members as part of the transfer plate. Pipette tip plate holder 16 in Carl allegedly does not include plug members or cylinders (See Figures 1-7) and instead includes openings through which cylinders 26 are moved.

The Examiner respectfully disagrees. The terms "having" or "including" in patent parlance does not necessarily mean "part of" or "connected to". The transfer plate 16 includes the plug members 26 in the transfer plate 16 throughout the operation of the Carl device. Thus, giving the claims the broadest reasonable interpretation, the transfer plate 16 of Carl has (i.e. includes) a plurality of plug members 26.

Applicant also argues that although frame 18 in Carl does have openings contained therein, the frame 18 allegedly does not have protuberances smaller than the plug members (or cylinders) extending into the openings. Instead, Carl discloses O-rings 22 with precision washers 28 for each disposable pipette tip in pipette tip plate 18 (See col. 3, lines 11-13).

The Examiner respectfully disagrees. The frame 18 of Carl does have protuberances 22 (O-rings), 28 (washers) that extend into the opening to engage the pipette tips 20 (see Fig. 5). The O-rings 22 act as individual springs, transmitting the loading force from the plate 18 into the pipette tips 20 carried by plate 16 and into the

associate cylinder 26 supported in cylinder plate 24. The O-rings 22 compensate for the molding variations in the pipette tips 20 and other variations in pipette tip dimensions. In addition, as shown in Figs. 5-6, the protuberances are "smaller than" the plug members 26.

It is noted that Applicant has not set forth specific arguments with respect to the previous rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over Carl (US Patent No. 5,497,670).

Thus, for the reasons delineated above, the claims remain rejected over the cited prior art.

### ***Conclusion***

10. No claims are allowed.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is (571)272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKW

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1795